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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,502	01/15/2004	David Benderly	BENDERLY	6160
156	7590	11/07/2006	EXAMINER	
KIRSCHSTEIN, OTTINGER, ISRAEL & SCHIFFMILLER, P.C. 489 FIFTH AVENUE NEW YORK, NY 10017			HEINRICH, SAMUEL M	
			ART UNIT	PAPER NUMBER
			1725	

DATE MAILED: 11/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/758,502	Applicant(s) BENDERLY, DAVID	
	Examiner Samuel M. Heinrich	Art Unit 1725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-43 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 38-43 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 38-43 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 8-13 of U.S. Patent No. 6,662,716 in view of USPN 6,129,965 to Langan. Marking steps are described in USPN 6,662,716 in claims 8-13. Langan describes label manufacture and label shipping and subsequent label use at a site separate from the manufacture site. The instant claimed product manufacture steps and subsequent product use steps does not impart patentability to diamond marking because manufacture and use at different sites provides an advantage of rapid change capability of on-site manufacturing.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 38-43 are rejected under 35 U.S.C. 112, first paragraph, because the steps of "heating the fusible material ... to melt the fusible material and form cavities in the gemstones" in non-enabling. Heating the fusible material to form a cavity in the gemstone is not clearly described. The specification does not enable any person skilled in the art to which it pertains to perform the invention commensurate in scope with these claims. Note, Hackh's Chemical Dictionary describes diamond as being unfusible.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 38-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,129,965 to Langan in view of USPN 6,329,631 to Yueh and in view of USPN 5,760,367 to Rosenwasser and in view of JP358087846A and in view of JP356057037A. Langan describes (column 1, lines 36-47) well known label manufacture and label shipping and subsequent label use at a site separate from the manufacture site. Langan does not describe applying stencils and subsequent marking objects. Yueh describe a well known stencil filled with fusible material such as metal. The use of a stencil such as disclosed by Yueh with a manufacture and shipping technique such as described by Langan would have been obvious at the time

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applicant's invention was made to a person having ordinary skill in the art because the stencil can be produced at one site and used at a different site intended for a different production. Rosenwasser et al describes (column 4, lines 24-32) gemstone marking comprising the use of a coating such as paint, ink or dye. JP358087846A describes (Abstract) the use of beam resist and direct exposure electron beam development and etching during manufacture of a semiconductor film. JP356057037A describes direct exposure patterning with a laser beam and resist film. The use of deposited material in a stencil in place of a coating and with a gemstone in place of a semiconductor at a manufacturing site would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art because the stencil provides readily available and reproducible marking material.

Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,129,965 to Langan in view of USPN 6,329,631 to Yueh and in view of USPN 5,760,367 to Rosenwasser and in view of JP358087846A and in view of JP356057037A as applied to claim 38 above, and further in view of USPN 4,179,322 to Brown et al. Brown et al describes the use of a cover layer and the use thereof with a carrier a marking material would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art because the cover protects the work piece prior to the use thereof.

Claims 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,129,965 to Langan in view of USPN 6,329,631 to Yueh and in view of USPN 5,760,367 to Rosenwasser and in view of JP358087846A and in view of

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JP356057037A as applied to claim 38 above, and further in view of Applicant's Admitted Prior Art (AAPA). AAPA describes (Specification, Description of the Related Art) related art which discloses well known application of marking material to diamonds including custom inscriptions and graphics. The use of a diamond workpiece with a marking process would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art because marking of diamonds for identification has been done at least for decades.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited art pertains to energy beam exposure and coating.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel M. Heinrich whose telephone number is 571-272-1175. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, P. Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Samuel M Heinrich
Primary Examiner
Art Unit 1725

SMH